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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,060	08/02/2001	Marty Steinberg	99997.023404	6179

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,060

Applicant(s)

STEINBERG, MARTY

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2 April 03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 13, line 1, "the consumer is offered with promotion" is indefinite.

At claim 18, lines 3-4, "from at least one of the offering companies" is indefinite. This rejection can be overcome by amending the phrase to "from the at least one of the offering companies company".

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-11 and 14-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggleston et al. (US006061660A).
6. Eggleston et al. teaches (independent claims 1, 16, 22 and 23) method and system for managing purchasing incentives offered to consumers, the method comprising:

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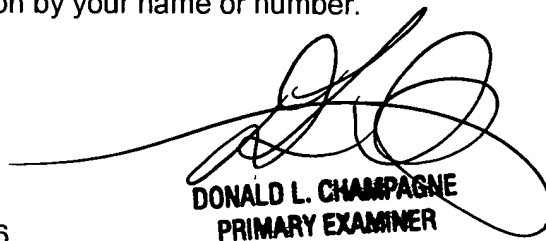
receiving information on membership in loyalty programs of offering companies and organizations from a plurality of consumers (col. 12 lines 22-25 and col. 13 lines 20-21); receiving a query from at least one consumer for available purchasing incentives for a product or service (col. 12 lines 49-53 and col. 16 lines 30-32); processing the query and transmitting information relating to the availability of purchasing incentives in response to the query of the consumer (col. 12 lines 40-48).

7. Eggleston et al. also teaches at the citations given above claims 6, 15 and 21.
8. Eggleston et al. also teaches: claims 2-5, 8 and 17-20 (col. 14 lines 7-25, where for claims 5 and 18 querying *sponsor database 202* reads on transmitting the query to a plurality of offering companies and organizations); claims 9-11 (col. 18 lines 46-57); and claim 14 (col. 15 lines 8-12).
9. Claims 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable Eggleston et al. (US006061660A).
10. Eggleston et al. does not teach (claim 7) storing the query in a searchable database. Because the queries would be useful marketing information for the offering companies/ sponsors, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that the query be stored in searchable *consumer database 200*.
11. Eggleston et al. does not teach (claim 12) that at least some of the marketing information is transmitted anonymously. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to guard the privacy of consumers by anonymous dissemination of consumer data. Because it is obvious to follow common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that at least some of the marketing information is transmitted anonymously.
12. Eggleston et al. does not teach (claim 13) offering compensation if no incentive is available in response to the query. Because it would enhance customer service, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eggleston et al. that compensation be offered if no incentive is available in response to the query.

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### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
14. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

  
**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

24 June 2006